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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/463,681	01/31/2000	JOACHIM BLUM	PM266043	6649

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PILLSBURY WINTHROP, LLP
P.O. BOX 10500
MCLEAN, VA 22102

EXAMINER

MAYEKAR, KISHOR

ART UNIT	PAPER NUMBER
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1741

24

DATE MAILED: 11/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/463,681

Applicant(s)
J. Blum et al.

Examiner
Kishor Mayekar

Art Unit
1741



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 17, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 102 and § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-8 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by SOLTWEDEL et al. (5,624,978) in light of the Merriam-Webster's Collegiate Dictionary, 10th edition, pages 130 and 891, to the definition of the terms "bonding" and "plastic". SOLTWEDEL's invention, a reference cited in the previous Office action, is directed to an aqueous coating composition which renders a metallic substrate capable of severe drawing without sacrificing corrosion protection or electrocoatability (emphasis added). SOLTWEDEL discloses the steps of applying the coating composition on the metal substrate utilizing known coil coating process and by any other known coating techniques to form a basecoat, and stoving the basecoat

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(col. 11, lines 11-18), wherein the basecoat has conductive properties imparted by conductive pigments in the coating composition (col. 10, lines 40-48). SOLTWEDEL also discloses that the basecoated substrate can then be conventionally coated or electrocoated with primer coatings and then may be coated or electrocoated with decorative topcoats and that the basecoat improves the adhesive bond between additional coatings and the metal substrate, such as the topcoat adhesion (see abstract; col. 2, lines 54-59; Examples 1 and 2; col. 14, lines 50-61). The Merriam-Webster's Collegiate Dictionary defines

- o "plastic", a copy of the definition cited in the last Office action, as "any of numerous organic synthetic or processed materials that are mostly thermoplastic or thermosetting polymers of high molecular weight and that can be made into objects, films, or filaments"; and
- o "bonding" as "causing to adhere firmly".

As to the subject matter of claims 4 and 11, SOLTWEDEL discloses that the basecoat is on both sides of the metal coil substrate (col. 9, lines 52-57).

As to the subject matter of claim 5, SOLTWEDEL that the basecoated

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substrate is formable and may be weldable (col. 11, lines 30-31).

As to the subject matter of claim 6, SOLTWEDEL discloses the spot welding of the basecoated steel panels (col. 11, lines 64-66).

As to the subject matter of claim 8, SOLTWEDEL discloses that the aqueous composition is useful to provide pretreatment coatings on metal; substrates used in the automotive (col. 2, lines 47-50).

3. Claims 9 and 10 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over SOLTWEDEL '978 in light of the Merriam-Webster's Collegiate Dictionary. The reference is applied as above. For the difference, since the above claims are drafted in "product-by-process" format, how the claimed product differs from the product disclosed in the applied reference is not apparent. It is well settled that the determination of the patentability of "a product-by-process" claim is based on the product itself, and the product is unpatentable if it appears to be the same as, or slightly different from the prior art products which were prepared in a different manner, *In re Thorpe* 227 USPQ 964.

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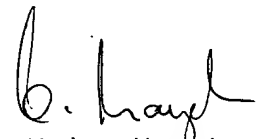
Response to Arguments

4. Applicant's arguments filed August 19, 2002 have been fully considered but they are not persuasive in view of the new ground rejection as set forth in the paragraph above.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kishor Mayekar whose telephone number is (703) 308-0477. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen, can be reached on (703) 308-3322. The fax phone number for this Group is (703) 872-9310 (non-after finals) or 872-9311 (after final).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.


Kishor Mayekar
Primary Examiner
Group 1700

KM
November 21, 2002

artillery or bombers 2: to assail vigorously or persistently (as with questions) 3: to subject to the impact of rapidly moving particles (as electrons) *syn* see ATTACK — **bombardment** \-mənt\ *n*
bombardier \bām-bā-'dir, -bār-\ *n* (1560) 1 *a* *archaic*: ARTILLERYMAN 2: a noncommissioned officer in the British artillery 3: a bomber-crew member who releases the bombs
bombardone \bām-bār-'dōn, bām-'bār-d'n\ *n* [F, fr. It *bombardone*] (1856) 1: a bass tuba 2: the bass member of the shawm family
bombast \bām-'bast\ *n* [ME *bombast* cotton padding, fr. MF *bombace*, fr. ML *bombac*, *bombax* cotton, alter. of L *bombyx*, *bombyx* silkworm, silk, fr. Gk *bombyx*, *bombyx*] (1589): pretentious inflated speech or writing
bombastic \bām-'bas-tik\ *adj* (1704): marked by or given to bombast: POMPOUS, OVERBLOWN — **bombastically** \-ti-k(ə)-lē\ *adv*
bombazine \bām-bā-'zēn\ *n* [MF *bombasin*, fr. ML *bombacinum*, *bombycinum* silken texture, fr. L, neut. of *bombycinus* of silk, fr. *bombyx*, *bombyx*] (1572) 1: a twilled fabric with silk warp and worsted filling 2: a silk fabric in twill weave dyed black
bombe \bām, 'bō-(m)b\ *n* [F, lit., bomb] (1892): a frozen dessert usu. containing ice cream and formed in layers in a mold
bombé or **bombe** \bām-'bā, 'bō-\ *adj* [F, fr. *bombe*] (1904): having outward curving lines — *usu.* used of furniture
bombed \bāmd\ *adj* (1959): affected by alcohol or drugs: DRUNK, HIGH
bomber \bā-'mər\ *n* (1915) 1: one that bombs; *specif*: an airplane designed for bombing 2: BOMBER JACKET
bomber jacket *n* (1952): a zippered usu. leather jacket with front pockets and knitted cuffs and waistband
bombinate \bām-bō-'nāt\ *vi* -**nat-ed**; -**nat-ing** [NL *bombinatus*, pp. of *bombinare*, alter. of L *bombilare*, fr. *bombyx*] (1880): BUZZ, DRONE
bombination \bām-bō-'nā-shən\ *n*
bombproof \bām-'prūf\ *adj* (1702): safe from the force of bombs
bombshell \bām-'shel\ *n* (1708) 1: BOMB 1a 2: one that is stunning, amazing, or devastating (the book was a political ~)
bomb-sight \-'sīt\ *n* (1917): a sighting device for aiming bombs
bona fide \bō-'nā-'fid, -'bā-, bō-'nā-'fi-'dē, -'fi-'dē\ *adj* [L, lit., in good faith] (1788) 1: made in good faith without fraud or deceit (a *bona fide* offer to buy a farm) 2: made with earnest intent: SINCERE 3: neither specious nor counterfeit: GENUINE *syn* see AUTHENTIC
bona fides \bō-'nā-'fi-'dēz, -'bō-'nā-'fidz\ *n* [L, lit., good faith] (1798) 1: good faith: SINCERITY 2: the fact of being genuine — often pl. in constr. 3: evidence of one's good faith or genuineness — often pl. in constr. 4: evidence of one's qualifications or achievements — often pl. in constr.
bonanza \bō-'nā-'zā\ *n* [Sp, lit., calm sea, fr. ML *bonacia*, alter. of L *malacia*, fr. Gk *malakia*, lit., softness, fr. *malakos* soft] (1844) 1: an exceptionally large and rich mineral deposit (as of an ore, precious metal, or petroleum) 2: a: something that is very valuable, profitable, or rewarding (a box-office ~) b: an extremely large amount (expected a ~ of sympathy)
Bonapartism \bō-'nā-'pār-'ti-zəm\ *n* (1815) 1: support of the French emperors Napoleon I, Napoleon III, or their dynasty 2: a political movement associated chiefly with authoritarian rule usu. by a military leader ostensibly supported by a popular mandate — **Bonapartist** \-'pār-'tist\ *n* or *adj*
bon-bon \bān-'bān\ *n* [F, redupl. of *bon* good, fr. L *bonus* — more at BOUNTY] (1796): a candy with chocolate or fondant coating and fondant center that sometimes contains fruits and nuts
bond \bānd\ *n* [ME *band*, *bond* — more at BAND] (12c) 1: something that binds or restrains: FETTER 2: a binding agreement: COVENANT 3: a: a band or cord used to tie something b: a material or device for binding c: an attractive force that holds together the atoms, ions, or groups of atoms in a molecule or crystal d: an adhesive, cementing material, or fusible ingredient that combines, unites, or strengthens 4: a uniting or binding element or force: TIE (the ~ of friendship) 5: a: an obligation made binding by a money forfeit; also: the amount of the money guarantee b: one who acts as bail or surety c: an interest-bearing certificate of public or private indebtedness d: an insurance agreement pledging surety for financial loss caused to another by the act or default of a third person or by some contingency over which the third person may have no control 6: the systematic lapping of brick in a wall 7: the state of goods made, stored, or transported under the care of bonded agencies until the duties or taxes on them are paid 8: a 100-proof straight whiskey aged at least four years under government supervision before being bottled — *called also* **bonded whiskey** 9: BOND PAPER
bond *vi* (1677) 1: to lap (as brick) for solidity of construction 2: a: to secure payment of duties and taxes on (goods) by giving a bond b: to convert into a debt secured by bonds c: to provide a bond for or cause to provide such a bond (~ an employee) 3: a: to cause to adhere firmly b: to embed in a matrix c: to hold together in a molecule or crystal by chemical bonds ~ *vi*: to hold together or solidify by or as if by means of a bond or binder: COHERE — **bond-able** \bān-'dā-bəl\ *adj* — **bond-er** *n*
bond *adj* [ME *bonde*, fr. *bonde* peasant, serf, fr. OE *bōnda* householder, fr. ON *bōndi*] (14c) *archaic*: bound in slavery
bondage \bān-'dij\ *n* (14c) 1: the tenure or service of a villein, serf, or slave 2: a state of being bound usu. by compulsion (as of law or mastery): as: CAPTIVITY, SERFDOM b: servitude or subjugation to a controlling person or force (young people in ~ to drugs)
bonded \bān-'dēd\ *adj* (1945): composed of two or more layers of the same or different fabrics held together by an adhesive (~ jersey)
bondholder \bān-'hōl-dər\ *n* (1823): one that holds a government or corporation bond
bonding *n* (1976) 1: the formation of a close personal relationship (as between a mother and child) esp. through frequent or constant association 2: the attaching of a material (as porcelain) to a tooth surface esp. for cosmetic purposes
bondmaid \bān(d)-'mā-d\ *n* (1526) *archaic*: a female bond servant
bondman \bān(d)-'mān\ *n* (13c): SLAVE, SERF
bond paper *n* (ca. 1877): a durable paper orig. used for documents
bond servant *n* (15c): one bound to service without wages; also: SLAVE

bondsman \bān(d)-'z-mān\ *n* (1713): one who assumes the responsibility of a bond: SURETY
bondsman *n* (1735): BONDMAN
bondstone \bān(d)-'stōn\ *n* (ca. 1845): a stone long enough to extend through the full thickness of a wall to bind it together
bondwoman \bān-'dwū-mān\ *n* (14c): a female slave
bone \bōn\ *n*, often attrib [ME *bon*, fr. OE *bān*; akin to OHG & ON *bein* bone, and perh. to OIr *benaid* he hews] (bef. 12c) 1: a: one of the hard parts of the skeleton of a vertebrate b: any of various hard animal substances or structures (as baleen or ivory) akin to or resembling bone c: the hard largely calcareous connective tissue of which the adult skeleton of most vertebrates is chiefly composed 2: a: ESSENCE, CORE (cut costs to the ~) (a liberal to the ~) b: the most deeply ingrained part: HEART — *usu.* used in pl. (knew in his ~s that it was wrong) 3: pl a (1): SKELETON (2): BODY (rested my weary ~s) (3): CORPSE (inter a person's ~s) b: the basic design or framework (as of a play or novel) 4: MATTER, SUBJECT (a ~ of contention) 5: a: pl: thin bars of bone, ivory, or wood held in pairs between the fingers and used to produce musical rhythms b: a strip of whalebone or steel used to stiffen a corset or dress c: pl: DICE 6: something that is designed to placate: SOP 7: a light beige — **boned** \bōnd\ *adj* — **bone-less** \bōn-'las\ *adj* — **bone to pick**: a matter to argue or complain about
bone *vb* **boned**; **bon-ing** *vi* (15c) 1: to remove the bones from (~ a fish) 2: to provide (a garment) with stays ~ *vi*: to study hard: GRIND (~ through medical school)
bone *adv* (ca. 1825): EXTREMELY, VERY (~ tired); also: TOTALLY
bone ash *n* (1622): the white porous residue chiefly of tribasic calcium phosphate from bones calcined in air used esp. in making pottery and glass and in cleaning jewelry
bone black *n* (1815): the black residue chiefly of tribasic calcium phosphate and carbon from bones calcined in closed vessels used esp. as a pigment or as a decolorizing adsorbent in sugar manufacturing — *called also* **bone char**
bone china *n* (ca. 1895): translucent white china made with bone ash or calcium phosphate and characterized by whiteness
bone-dry \bōn-'dri\ *adj* (ca. 1825) 1: very dry 2: DRY 5
bone-fish \bōn-'fīsh\ *n* (1884) 1: a slender silvery small-scaled fish (*Athala vulpes*) that is a notable sport and food fish of warm seas 2: LADYFISH 2 — **bone-fishing** *n*
bone-head \bōn-'hed\ *n* (1909): a stupid person: NUMSKULL — **bone-head-ed** \-'he-'dēd\ *adj* — **bone-head-ed-ness** *n*
bonehead *adj* (1915): being a college course for students lacking fundamental skills (teaches ~ English)
bone-meal \bōn-'mē(ə)\ *n* (1850): crushed or ground bone used esp. as fertilizer or feed
bon-er \bō-'nər\ *n* (ca. 1899) 1: one that bones 2: HOWLER 2
bone-set \bōn-'set\ *n* (1764): any of several composite herbs (genus *Eupatorium*); esp.: a perennial (*E. perfoliatum*) with opposite perfoliate leaves and white-rayed flower heads used in folk medicine
bone-setter \-'se-'tər\ *n* (15c): a person who sets broken or dislocated bones usu. without being a licensed physician
bone up *vi* (1887) 1: to try to master necessary information quickly: CRAM (bone up for the exam) 2: to renew one's skill or refresh one's memory (boned up on the speech just before giving it)
bone-yard \-'yārd\ *n* (1866) 1: CEMETERY 2: a place where worn-out or damaged objects (as cars) are collected to await disposal
bon-fire \bān-'fir\ *n* [ME *bonfire* a fire of bones, fr. *bon* bone + *fire*] (15c): a large fire built in the open air
bon \bāg, 'bōn\ *n* [imit.] (1860): the deep resonant sound esp. of a bell — **bon** *vb*
bon *n* [Thai *bhaung*] (1971): a simple water pipe consisting of a bottle or vertical tube partially filled with a liquid (as water or liquor) and a smaller offset tube ending in a bowl
bon-go \bān-'gō, 'bōn-\ *n*, pl **bonagos** also **bongoes** [AmerSp *bongo*] (1920): one of a pair of small connected drums of different sizes and pitches played with the hands — **bon-go-ist** \-'gō-'ist\ *n*
bongo *n*, pl **bongo** or **bonagos** [prob. fr. Kele (Bantu language of Gabon)] (1861): an African antelope (*Tragelaphus euryceros* syn. *Boceros euryceros*) that is chestnut-red with narrow white vertical stripes and is found in forests from Sierra Leone to Kenya
bon-ho-mie \bā-'nā-'mē, 'bō-\ *n* [F *bonhomme*, fr. *bonhomme* good-natured man, fr. *bon* good + *homme* man] (1779): good-natured easy-friendliness — **bon-ho-mous** \bā-'nā-'məz\ *adj*
bon-i-face \bā-'nā-'fas, -'fās\ *n* [Boniface, innkeeper in *The Beaux' Stratagem* (1707) by George Farquhar] (1803): the proprietor of a hotel, nightclub, or restaurant
bon-i-to \bā-'nē-(t)ō, -'nē-'tō\ *n*, pl -**tos** or -**to** [Sp, fr. *bonito* pretty dim. of *bueno* good, fr. L *bonus*] (ca. 1565): any of several scombrofishes (esp. genera *Sarda* and *Euthynnus*) intermediate between the smaller mackerels and the larger tunas
bon-kers \bān-'kəz, 'bōn-\ *adj* [perh. fr. *bonk* to hit, bang + *-ers* (as *crackers*)] (ca. 1948): CRAZY, MAD (if I don't work, I go ~ — Zoe Caldwell)
bon mot \bōn-'mōt\ *n*, pl **bons mots** \bōn-'mōz\ or **bon mōt** \-'mōz\ [F, lit., good word] (ca. 1730): a clever remark: WITNESS
bonne \bōn\ *n* [F, fem. of *bon*] (1771): a French nursemaid, maid, or servant
bon-net \bā-'nēt\ *n* [ME *bonet*, fr. MF, prob. of Gmc origin; akin to OS *gibund* bundle, OE *bindan* to bind] (14c) 1: a (1) chiefly Scot: man's or boy's cap (2): a brimless Scotch cap of seamless wool fabric — compare TAM-O-SHANTER 2: a cloth or straw hat tied under the chin and worn by women and children 2: a Brit: an automobile hood b: a metal covering or cowl (as for a fireplace, valve, boiler, or ventilator)
bonnet *vi* (1858): to provide with or dress in a bonnet
bon-net also **bon-nie** \bā-'nē\ *adj* **bon-nier**; -**est** [ME *bonie*, fr. *bon* good, fr. L *bonus*] (15c) chiefly Brit: ATTRACTIVE, FAIR; also: EXCELLENT — **bon-ni-ly** \bā-'nē-'lē\ *adv*
bon-ny-clab-ber \bā-'nē-'kla-bər\ *n* [fr. *bainne clabair*, fr. *bainne* + *clabair*, gen. of *clabair* sour thick milk] (1616) Northern & Midland: CLABBER
bon-sai \bōn-'sī, 'bōn-, 'bān-, also 'bān-'zī\ *n*, pl **bonsai** [Jp, lit., planting] (1900): a potted plant (as a tree) dwarfed and trained